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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/840,859      | 04/24/2001  | Adam G. Malofsky     | 7962801/502         | 5663             |

7590 08/01/2005

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| EXAMINER |
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ZIRKER, DANIEL R

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| ART UNIT | PAPER NUMBER |
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1771

DATE MAILED: 08/01/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/840,859

Applicant(s)

MALOFKY ET AL.

Examiner

Daniel Zirker

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 6/24/04, 10/20/04 and 9/21/04.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453.O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-67 and 113 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9, 11-66 and 113 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

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1. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

2. Claims 1-9, 11-66 and 113 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. More particularly, applicants' independent claims as recently amended contain language which makes the essential structure of the claimed fastening device unclear to one of ordinary skill. In these claims the phrase, "when a test surface...." implies that the "test surface" element is not part of the article, but this clearly contradicts the last three lines of claims 1 and 60, and the last two lines of claim 113. Additionally the aforementioned amendments to the end of claims 1 and 60 and the corresponding disclosure to claim 113 all refer to "contact .... as measured by the post-bonding test procedure defined herein" which the Examiner submits is vague and indefinite. Additionally, this particular clause is believed to rely on support from former dependent claim 10, which relied upon original claim 6 for support, and which required the believed impossible contact of the test surface with the adhesive layer on its inward surface, which adhesive layer was already contacting the susceptor on its inward surface to also contact on this inward surface with the test surface – an impossibility; this analysis is believed correct for all three independent claims. Finally, claim 113 recites in its last three lines not only contact with the adhesive as measured by the post bonding test, but also the test surface is "in pre-bonding contact" with the adhesive; clarification or correction for not only this but the other informalities in the independent claims is respectfully requested. With respect to the dependent claims

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"pressure-activated adhesive" in claim 23 is not art recognized terminology, and in claim 55 "nestable tape" is not understood. Finally, claim 62 appears to be a duplicate of claim 61, since this claim already contains the thickness limitation of claim 62.

Additionally, other informalities may have been overlooked and applicants are urged to correct them.

3. Claims 1-9, 11-66 and 113 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which are not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. More particularly, as was pointed out in the preceeding paragraph, applicants' claims appear to describe embodiments which are not believed set forth in the specification and which are not in certain instances believed capable of existing. The Examiner is particularly concerned with those embodiments which recite the presence of the susceptor sheet, a layer of adhesive which is believed to partially cover the susceptor, and the "test surface" which "contacts" part of the adhesive layer on the inward surface of the adhesive (which adhesive is also believed to be contacting the susceptor surface). Additionally, such elements as the test surface being in some vaguely defined both pre-bonding and post bonding contact with the adhesive, and a "test procedure" that is vaguely set forth in the claims as "defined herein" are believed to make the claimed invention and, it is believed, the disclosed invention nonenabling to one of ordinary skill..

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4. Claims 1-9, 11-66 and 113 are rejected under 35 U.S.C. 103(a) as being unpatentable over either Perrin et al or Jackson et al, each taken in view of Brooks, cited as evidence of the state of the art, substantially for reasons previously set forth, together with the following additional observations. More particularly, while the Examiner no longer relies upon an anticipation rejection primarily because neither primary reference teaches a specific partial adhesive covering of the susceptor surface, he still believes that the claimed invention is intended to read upon a thin, presumably metal sheet characterized as a "susceptor" which is coated with a suitable heat activated adhesive on at least one surface. Additionally, in order to meet the claimed performance parameters regarding its relationship with the congruent test surface is believed to require in many instances only the presence of, e.g. a wide variety of substantially flat surfaces such as are either disclosed by the references or would be a routine modification to one of ordinary skill in the heat transfer laminate art. With respect to the particular geometric patterns that the adhesive layer may take note again Brooks, particularly at Col 3, lines 31-37, particularly lines 35-37 that the adhesive may be provided in almost any pattern, either, e.g. as a continuous layer or in either a longitudinally extending ribbon or bead, or as individual beads or the like and of the size dimensions that applicants claim. With respect to the Holzer affidavit it is again respectfully submitted that the showing is not nearly commensurate in scope with applicants' claims, and applicants remarks (Response, page 16, middle paragraph) that stronger adhesive bonds are attained in many, if not all instances by using less adhesive is respectfully disagreed with. Note also that applicants' contention that

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Brooks "...is teaching away from the use of patterns and teaches nothing of the specific patterns as required and defined by the present claims" is respectfully disagreed with in view of the aforementioned broad language already referred to in Brooks regarding the level of ordinary skill in the art. Finally applicants remarks (Response, page 15, complete Paragraphs 1 and 3) each appear to overlook the fact that each of the primary references are relied upon in combination, not individually. In summary, the prima facie case of record is not seen to have been rebutted..

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Daniel Zirker whose telephone number is 571-272-1486. The examiner can normally be reached on Monday-Thursday from 8:30 to 6:00. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel Morris, can be reached on 571-272-1486. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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Daniel Zirker  
Primary Examiner  
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*Daniel Zirker*